

oxides are present in an amount of about 0.1 to about 30%, and the powder is present in an amount of about 2 to about 15%, each by weight of the composition.

33(amended). The composition of claim 30 in which the interference pigment is present in amount of about 2 to about 8% by weight of the composition.

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REMARKS

I. Rejection under 35 USC §112, second paragraph

Claims 6, 12-14, 17-20, 24, 32 and 33 have been rejected under 35 USC §112, second paragraph as failing to particularly point out and distinctly claim the invention. With respect to claims 6, 12-14, 17-20 and 24, it is stated that the claims are indefinite because of the use of the term "non-matte". It is the Examiner's position that whether or not a powder confers a matte finish is relative, and that the examples and the preferred embodiments are not exclusive. The Examiner states that Applicants have not provided any guidance as to how to measure or determine whether a powder is non-matte.

Applicants once again traverse this rejection. First, with respect to the alleged failure to provide guidance of how to measure matteness, it is well recognized that an application does not have to disclose, and in fact preferably omits, disclosure of what is known in the art. Means for determining matteness or glossiness are known to those of ordinary skill in the art; as an example, the Examiner is referred to example II of US Patent No. 6,027,738, accompanying this amendment. This document clearly shows that means are known in the art, and have been publicly disclosed, for measuring glossiness vs. matteness. Since Applicants have further also explicitly provided an extensive list of those powders that Applicants define as non-matte powders, one skilled in the art, upon being faced with the question of whether a powder not listed is a non-matte powder, can simply compare the matteness conferred by the powder in question with that of any

powder expressly identified on the list, by the means known and documented in the art, and have a simple, clear answer to the question. Therefore, Applicants have indeed provided adequate disclosure on the meaning of "non-matte" to a person of ordinary skill in the art.

With respect to claims 32 and 33, these claims have been amended to clarify that the percentages are by weight, as clearly supported in the examples and the specification.

In view of the arguments and amendments provided herein, withdrawal of the rejection of claims 6, 12-14, 17-20, 24, 32 and 33 under 35 USC §112, second paragraph, be reconsidered and withdrawn.

## II. Rejections under 35 USC §102

Claims 1-8 and 12-17 remain rejected under 35 USC §102(b) as being anticipated by Kimura et al. for the reasons stated in the previous rejection. The Examiner has stated in the previous office action that the Kimura reference teaches a composition containing a blue interference pigment, a metal oxide and an inorganic nonspherical powder, as required some of the present claims. Applicants had argued that the Kimura document teaches a method of concealing discoloration on the skin, whereas the present claims are directed to a method for reducing the appearance of lines and wrinkles. In response to these arguments, in the present rejection the Examiner states that the present method claims a step of applying a composition to the skin, which Kimura teaches, and that the present claims do not require application to lined or wrinkled skin. It is further stated by the Examiner that "since all skin has lines and/or wrinkles, application of a composition containing the same components...inherently reduces the appearance of lines and wrinkles".

Applicants have amended the present claims to specify that in the method of the invention, the composition is applied to skin exhibiting lines or wrinkles. This amendment addresses the Examiner's point that the claims are not limited to applying the composition to lined or

wrinkled skin. However, Applicants must traverse the Examiner's position that all skin contains lines and/or wrinkles. This statement has been made without any technical support whatsoever, and is legally insufficient to provide the basis for the Examiner's inherency argument. If the Examiner has some supporting evidence to buttress this position, it must be provided to render this rejection valid. A statement that is merely conclusory in nature, without any factual evidence to back it up, cannot be used by the PTO to support a rejection. *In re Lee*, Fed. Cir. 00-1158, 1/18/02. Is it the Examiner's position that a newborn baby necessarily possesses lined and wrinkled skin? Or is the Examiner posing the argument that an individual in applying the Kimura composition to a port wine stain on an upper arm is inherently treating skin exhibiting lines and wrinkles? If so, there is simply no basis for either of these positions. As has been stated previously, the case law governing inherency requires that the intended result must undeniably and irrefutably flow from the prior art disclosure. *Hughes Aircraft Co. v. United States*, 8 USPQ 2d 1580 (Ct. Cl. 1988), and the mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Oelrich and Divigard*, 212 USPQ 323 (CCPA 1981). If the Examiner persists in the position presented in this current office action, then there must be unequivocal evidence provided that shows treatment of lines and wrinkles are undeniably and irrefutably reduced in appearance by following the teachings of the Kimura reference. As the case law clearly states, if it is only a possibility that this might occur, this is inadequate to support a holding of inherency. Since the Examiner has failed to support the arguments presented with any facts whatsoever, the arguments are legally insufficient and must be withdrawn.

Claims 1-5, 9, 21-23, 25, 26 and 29 have also been rejected under 35 USC §102(e) as being anticipated by WO 99/66883 for the reasons stated in the previous rejection. That rejection stated that the '883 reference teaches compositions containing at least one interference

pigment and at least one non-interference pigment, and that the compositions are used to treat skin flaws and defects. Applicants responded that there is no disclosure of a blue or violet interference pigment to be found in '883, and therefore there could be no anticipation. In the current office action, in response to Applicants' arguments, the Examiner states that '883 discloses the same pigments as disclosed by Applicants as interference pigments, and that "all disclosures in a reference must be evaluated, including non-preferred embodiments. Specifically, the Examiner notes that a reference is not limited to the disclosure of the specific working examples, citing *In re Mills*.

Applicants do not dispute that the review of a reference is not restricted to the working examples. However, Applicants have scoured the entire text of the '883 reference and have failed to find any disclosure of a blue or violet interference pigment. If the Examiner has actually found such a reference, it is respectfully requested that this be pointed out to Applicants. Although the references claims might well by their language encompass a blue or violet interference pigment, it is unequivocal that there is no disclosure of same anywhere to be found in this document. The *Mills* case does not apply to the facts of the present case, in that the reference in question in *Mills* expressly did disclose the disputed disclosure, just not in the working examples. The fact that something *might* be included within the scope of the claims does not amount to a disclosure of that thing, and that is the situation of the present case.

The Examiner cannot take the position that there is anywhere disclosed in this reference the application to the skin of a composition containing a blue or violet interference pigment, because such a disclosure simply does not exist. In order for this reference to anticipate, the reference must disclose each and every element of the present claims. The Examiner cannot read the missing disclosure into the reference when it plainly is not there, whether or not it may be encompassed within the scope of the claims. Because there is no

disclosure of this essential element of the present claims, the '883 reference cannot be found to anticipate these claims. The case law on this point is quite clear: A claim is anticipated only when a single reference discloses each and every element of the claim. *Glaxo Inc. v Novopharm Ltd.*, 34 USPQ2d 1565 (Fed.Cir. 1995). The disclosure must describe the subject matter with sufficient clarity and detail to prove its existence in the prior art. *In re Spada*, 15 USPQ2d 1655 (Fed. Cir. 1990). It is indisputable that the Examiner has not shown that a blue or violet interference pigment is disclosed in the '883 pigment in such a way that one skilled in the art would recognize that such a pigment would be capable of reducing the appearance of lines and wrinkles. In the view of the absence of such a showing, the withdrawal of the anticipation rejection based on the '883 reference is respectfully requested.

## II. Rejection under 35 USC §103(a)

Claims 1-34 have been rejected under 35 USC §103(a) as being unpatentable over either of the '916 or '883 documents, for the reasons stated in the previous rejection. The reasons stated in the previous rejection were as follows:

Kimura et al. teaches all the limitations of the claims as stated above. It does not teach about 1-9% by weight of interference pigment, about 0.1 to 30% of a metal oxide, and about 2-20% of bismuth oxychloride. WO teaches all the limitations of the claims as stated above. It does not teach inorganic, non-matte, non-spherical powders.

Kimura et al. teaches inorganic, non-matte, non-spherical powders such as bismuth oxychloride as stated in the 35 USC 102(b) rejection above. WO '883 teaches a weight percent of components within the instantly claimed ranges as stated in the 35 USC 102(e) rejection above. WO '883 teaches ... that it is within the skill in the art to determine an optimum concentration of interference pigment in order to achieve a desired effect. Each reference makes up the deficiencies of the other.

Applicants, in response to this rejection in their previous amendment, pointed out that the present claims are directed to a combination of very specific components, i.e., a blue or violet interference pigment combined with a metal oxide, used for the express purpose of reducing the appearance of lines and wrinkles, and that it is not the generic combination of any interference pigment with a metal oxide to disguise "skin flaws". Applicants also noted that neither reference addresses the problem of lines and wrinkles, each primarily focusing on the issue of skin discoloration, and neither noted any unique properties of blue or violet pigments for this purpose, as opposed to any other pigments mentioned in the references. It was Applicants' position that since neither document mentioned the reduction of appearance of lines and wrinkles, and the only use for a blue pigment mentioned is for masking skin discoloration, even if the teachings were combined, one skilled in the art would still not achieve the method of the present invention. Also, the Examiner's statement that the determination of an optimum amount of interference pigment for a specific purpose is simply a distortion of what the '883 patent actually states. The sentence in the '883 document to which the Examiner is believed to refer to states as follows:

Given this guidance, it is within the skill of the art to determine an optimum concentration of interference pigment to achieve the final look desired.

This clearly does not state what the Examiner portrays, but in fact only suggests that given the guidance of that document, which prescribes a range of 0.05-90% of interference pigment, one skilled in the art could determine the appropriate amount for the particular purpose of the compositions taught in that document, which is not the reduction in the appearance of wrinkles or lines. It does not in any way suggest what percentage ought to be used if a different result from that disclosed in that document is being sought. The Examiner's

position is, therefore, not based on a fair reading of this document, but simply what the Examiner would like the document to say.

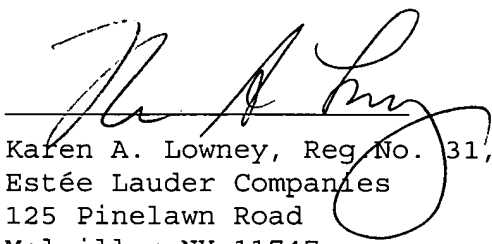
It is clear from the arguments presented above with respect to the anticipation rejections that neither of these documents fairly suggests that application of a composition containing a blue or violet pigment and a metallic oxide to skin exhibiting lines and wrinkles can reduce the appearance of those lines and wrinkles, since there is no disclosure in either document of the reduction of lines and wrinkles, and nothing in either document, alone or in combination that would suggest that a blue or violet pigment would have such an effect. Further, there is nothing in either document that would suggest a skin colored composition that contains from 1-9% of blue or violet pigment, combined with a metal oxide and a powder, particularly in the specific combination of about 0.1 to about 30% metal oxide and about 2 to about 15% powder. Notwithstanding the disclosure in both documents of many different types of pigments, with a very broad range of use, some of which overlap with those of the present invention, there is nothing to suggest the specific amounts in combination that are required by the present claims to achieve a result not taught in the prior art. Further, even assuming the composition were to be considered *prima facie* obvious in view of the cited art, the unexpected result of reducing lines and wrinkles would weigh against any such presumption of obviousness. The Examiner's position is based on a hindsight reconstruction of Applicants' invention by picking and choosing isolated teachings from the two cited references, combined with an unsupported assertion of the equivalence of "skin flaws" with lines and wrinkles, when the documents in question clearly do not corroborate such an interpretation. The PTO is not permitted to use such hindsight reconstruction in negating patentability. *In re Gorman*, 18 USPQ 2d 1885 (Fed.Cir. 1991); *In re Fine*, 5 USPQ 2d 1596 (Fed.Cir. 1988). Moreover, it is not permissible to support a rejection based on conclusory, unsupported statements. *In re Lee, supra*. For these reasons, the

obviousness rejection cannot be maintained, and withdrawal is respectfully requested.

CONCLUSION

The present claims are believed to be in condition for allowance, and prompt issuance of a Notice of Allowance is respectfully solicited. The Examiner is encouraged to contact the undersigned by telephone if it is believed that discussion will resolve any outstanding issues.

Respectfully submitted,



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Copy of claims marked to show changes

1(amended). A method of reducing the appearance of lines and wrinkles on the skin, which comprises applying to the skin exhibiting lines or wrinkles a makeup composition comprising an interference pigment having a blue or violet reflectance, combined with at least one metal oxide pigment.

32(amended). The composition of claim 30 in which the interference pigment is present in an amount of from about 1 to about 9%, the metal oxides are present in an amount of about 0.1 to about 30%, and the powder is present in an amount of about 2 to about 15%, each by weight of the composition.

33(amended). The composition of claim 30 in which the interference pigment is present in amount of about 2 to about 8% by weight of the composition.